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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/092,873	03/06/2002	Daniel R. Potter	005127.59792	9984

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EXAMINER

STASHICK, ANTHONY D

ART UNIT PAPER NUMBER

3728

DATE MAILED: 02/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/092,873

Applicant(s)

POTTER ET AL.

Examiner

Anthony D Stashick

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
4a) Of the above claim(s) 9-17 and 26-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 18-25 and 29-34 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2, 4.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Species I in Paper No. 6 is acknowledged. The election of Species requirement is hereby made **Final**.

Information Disclosure Statement

2. The information disclosure statement filed October 18, 2002 is not accompanied by a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. The US references have been reviewed since they are easily accessible, but the other references marked through on the IDS have not been reviewed as there is no copy available to review. If the applicant further desires review of these references, the applicant should submit a copy of the references in response to this Office Action to allow the examiner to properly consider the references.

Specification

3. The attempt to incorporate subject matter into this application by reference to the prior patents is improper because most of the prior patents incorporated by reference incorporate other references themselves. It is improper to incorporate by reference another reference which in itself incorporated by reference a previous reference. It appears that the essential subject matter of the references attempted to be incorporated by reference is along the lines of the material of the bladder and how the air diffuses through the material.
4. The disclosure is objected to because of the following informalities: Reference number 14 is referred to as a "chamber" throughout the written disclosure. This language used to describe part 14 is

Art Unit: 3728

confusing, as it appears that reference 14 is actually an insert that contains chambers 13 and not a chamber in and of itself. To clarify the description, it appears that reference number 14 should be referred to as an "insert" throughout the written disclosure. Appropriate correction is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-5 and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Town 2,762,134. Town '134 discloses all the limitations of the claims including the following: a bladder (Figure 1) for footwear comprising a sealed first chamber (formed by 101 and 11) being formed of a barrier material and containing fluid at a first pressure (ambient air); a sealed second chamber (formed by 14 and 15) formed of a second barrier material and containing fluid at a second fluid pressure greater than the first fluid pressure (second chamber sealed and pressurized); the second chamber being operatively coupled to the first chamber (located within the first chamber) such that inflation fluid from the second chamber moves into the first chamber as it leaves the second chamber to increase the fluid pressure and the amount of fluid within the first chamber (air leaves first chamber must travel into second chamber); the fluid contained in the first chamber includes a gas (air); the first chamber surrounds at least a portion of the second chamber (see Figures 2 and 3); the inflation fluid includes an inflation gas (air); the second chamber is formed of barrier material that is different from the barrier material of the first chamber (second chamber material must be as impervious as possible to the passage of air whereas this is not required of first chamber material); the barrier material of the second chamber is constructed so that inflation gas diffuses out of the second chamber and into the first over a

Art Unit: 3728

predetermined period of time (known failure time of material of second chamber); the second chamber releases gas to the first chamber by fatigue failure of the second chamber barrier material (second chamber breaks, fluid from second chamber enters first chamber).

7. Claims 1-6, 18-23, 29 and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by McLaughlin 5,979,078. McLaughlin '078 discloses all the limitations of the claims including the following: an upper for covering at least a portion of a foot of a wearer (see Figure 1, reference 75); a bladder 10 for footwear comprising a sealed first chamber (that formed by 50 and 55) being formed of a barrier material and containing fluid at a first pressure (see col. 4, lines 42-55); a sealed second chamber 15 formed of a second barrier material (see col. 3, lines 40-60) and containing fluid at a second fluid pressure greater than the first fluid pressure (see col. 4, lines 18-36); the second chamber being operatively coupled to the first chamber (located within the first chamber) such that inflation fluid from the second chamber moves into the first chamber as it leaves the second chamber to increase the fluid pressure and the amount of fluid within the first chamber; the fluid contained in the first chamber includes a gas (enclosed atmospheric air); the first chamber surrounds at least a portion of the second chamber (see Figures); the inflation fluid includes an inflation gas (see col. 4, lines 18-36); the second chamber is formed of barrier material that is different from the barrier material of the first chamber (see col. 3, lines 40-60 and col. 4, lines 42-55); the barrier material of the second chamber is constructed so that inflation gas diffuses out of the second chamber and into the first over a predetermined period of time (known diffusion property of material used for bladder 15); the second chamber releases gas to the first chamber by fatigue failure of the second chamber barrier material (second chamber breaks, first chamber receives gases from second chamber); the second chamber barrier material is more brittle than the first chamber material (see above noted type of material for use of bladder); the second chamber releases gas to the first chamber by diffusion of the gas through the

Art Unit: 3728

second chamber material over time (any gas that normally diffuses through material of bladder 15 will be caught by outer envelope).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 18-22 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Town 2,762,134 as applied above in view of Rees 2,677,906. Town '134 as applied above discloses all the limitations of the claims except for the article of footwear having an upper for covering at least a portion of the foot of the wearer. Although insole bladder s of the type disclosed in Town '134 are typically used in athletic shoes that have uppers attaching the shoe to the user's foot, Reed '906 teaches that a shoe with an upper can contain a cushioning bladder located within it. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to place the bladder of Town '134 into an athletic shoe with an upper, as taught by Reed '906, to aid in cushioning the user's foot during impact of the shoe with the ground.

10. Claims 7-8, 24-25, 30-31 and 33-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over McLaughlin 5,979,078 as applied to claims 3, 5, 19, 20, 29 and 32 above in view of Huang 5,902,660. McLaughlin '078 as applied above discloses all the limitations of the claims except for the second chamber having a preformed weakness and the second chamber releasing the inflation fluid to the first chamber by manual actuation of the chamber. Huang '660 teaches (Figure 11) that a bladder

Art Unit: 3728

with an internal chamber and an external chamber can have a weakness (the edge of the internal bladder) in the internal bladder that allows for the fluid of the internal bladder to exit the internal bladder and enter the external bladder, thereby inflating the external bladder. This allows for different inflation pressures to be placed within the inner and outer air cushions. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to make the internal bladder with an opening that was later closed to allow for the pressurization of the different air cushions by manual compression.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure are cited on form 892 enclosed herewith.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony D Stashick whose telephone number is 703-308-3876. The examiner can normally be reached on Monday through Thursday from 6:30 am until 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 703-308-2672. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 10/092,873

Page 7

Art Unit: 3728

A handwritten signature in black ink, appearing to read 'Anthony D Stashick', written in a cursive style.

Anthony D Stashick
Primary Examiner
Art Unit 3728

ADS